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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,993	12/21/2001	Jan Marie Desanti	52493.000119	8154

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EXAMINER

BOYCE, ANDRE D

ART UNIT PAPER NUMBER

3623

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/023,993	DESANTI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andre Boyce	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/30/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-4 have been examined.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 210 in Figure 1.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

3. Claim 2 is objected to because of the following informalities: Claim 2 lists the elements as "(a)" through "(q)", however claim 1 also recites elements "(a)" through

“(o)”. As a result, claim 2 has element designations that overlap with claim 1 that could make the claims confusing. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the employee" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claims 2-4 are also rejected based upon the same rationale.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In order to be considered useful, the claimed invention must possess a practical application. In order to be concrete, the result

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must be assured and reproducible. In order to be tangible, the result must involve more than a manipulation of an abstract idea.

In the present case, independent claim 1 provides neither a concrete nor a tangible result. Claim 1 recites identifying a marginal employee, determining whether the employee lacks motivation or lacks an ability to meet one or more job requirements, identifying further training that would give the marginal employee the ability to meet the one or more job requirements, defining at least one goal for enhanced performance of the marginal employee, defining a time period within which the marginal employee should achieve the at least one goal for enhanced performance, etc. However, the subjective nature of the claim language results in the invention lacking concreteness, since the result is not assured and reproducible. In other words, the invention could be practiced several times with various results, wherein the performance of the employee may or may not be enhanced. Claims 2-4 are rejected based upon the same rationale.

In addition, claims 1-3 are rejected because the results are not tangible. Here, the results do not involve anything more than a manipulation of an abstract idea, since the employer and employee are performing the steps mentally.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Allison (How to Manage Marginal Performers, September 1995).

As per claim 1, Allison discloses a method for enhancing the performance of a marginal employee (i.e., ensure marginal employees a fair opportunity to improve, abstract) comprising the steps of (a) an employer identifying a marginal employee (i.e., employee performance is of concern, ¶ 7); (b) the employer determining whether the employee lacks motivation or lacks an ability to meet one or more job requirements (i.e., employee shows a lack of willingness or ability to improve, ¶ 13); (c) the employer identifying further training that would give the marginal employee the ability to meet the one or more job requirements (i.e., additional skills or training, ¶ 7); (d) the employer defining at least one goal for enhanced performance of the marginal employee (i.e., specific objective of progress, ¶ 8); (e) the employer defining a time period within which the marginal employee should achieve the at least one goal for enhanced performance (i.e., time period established from monitoring, ¶ 8); (f) the marginal employee making a record of the marginal employee's understanding of the one or more job requirements (i.e., specific objectives committed to writing, ¶ 8); (g) the employer discussing with the marginal employee the one or more job requirements and the marginal employee's understanding of the one or more job requirements (i.e., verbal discussion of written agreement, ¶ 10); (h) the employer communicating to the marginal employee the at least one goal for enhanced performance and the time period

within which the marginal employee should achieve the at least one goal for enhanced performance (i.e., specific objectives and measurements committed to writing, including time period for monitoring, ¶ 8); (i) the employer communicating to the marginal employee one or more possible outcomes (i.e., employee may be demoted or terminated, if goals are not reached, ¶ 10); (j) the employer obtaining from the marginal employee an acknowledgement of the at least goal for enhanced performance and the time period within which the marginal employee should achieve the at least one goal for enhanced performance (i.e., verbal discussion of written performance improvement agreement, ¶ 10); (k) the employer making available the further training that would give the marginal employee the ability to meet the one or more job requirements (i.e., measures taken to provide additional skills or training, ¶ 7); (l) the employer monitoring the marginal employee's performance over the time period (i.e., time period for monitoring, ¶ 7); (m) the employer determining whether the at least one goal for enhanced performance was achieved during the time period (i.e., employee shows a lack of willingness or ability to improve, ¶ 13); (n) the employer determining whether an extension of the time period for the employee to achieve the at least one goal for enhanced performance is appropriate (i.e., give the employees another 30 days to improve, ¶ 13); and (o) the employer determining an appropriate outcome for the marginal employee (i.e., appropriate action to remove employee from the position or extend the time, ¶ 13).

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As per claim 3, Allison discloses the possible outcomes comprise a termination, a reassignment and a retention (i.e., employee may be demoted or terminated, if goals are not reached, ¶ 10).

As per claim 4, Allison discloses the step of documenting each step of the method (i.e., documentation of employer's efforts, ¶ 9).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allison (How to Manage Marginal Performers, September 1995), in view of Hadden et al (US 2003/0187723).

As per claim 2, Allison discloses (b) the employer considering the marginal employee's proximity to meeting the at least one goal for enhanced performance (i.e., relative progress has been made, but falls short of agreed upon objectives, ¶ 13); (c) the employer considering the marginal employee's steadiness of improvement in performance (i.e., relative progress has been made, ¶ 13); (d) the employer considering the marginal employee's ability to meet the one or more job requirements (i.e., employee clearly shows a lack of willingness or ability to improve, ¶ 13); (e) the employer considering the marginal employee's willingness



to meet the one or more job requirements (i.e., employee clearly shows a lack of willingness or ability to improve, ¶ 13); (f) the employer determining whether an appropriate time period for an extension exists (i.e., another 30 days to improve, ¶ 13); (g) the employer determining whether at least one extended goal for enhanced performance exists (i.e., more time given for the agreed upon objectives or measures, ¶ 13); (h) the employer determining whether the at least one extended goal for enhanced performance and the extension of the time period for achieving the at least one goal for enhanced performance have been documented (i.e., employees acknowledge reason for time extension in writing, ¶ 13); (i) the employer determining whether the at least one extended goal for enhanced performance and the extension of the time period for achieving the at least one goal for enhanced performance have been discussed with the marginal employee (i.e., acknowledged in writing, ¶ 13); (j) the employer determining whether the extension would be consistent with the employer's treatment of other marginal employees (i.e., timetables must be realistic out of fairness to all employees, ¶ 8); (k) the employer determining whether any additional training is recommended for the marginal employee (i.e., measures taken to provide additional skills or training, ¶ 7); (l) the employer determining whether the additional recommended training is available (i.e., measures taken to provide additional skills or training, ¶ 7); (m) the employer determining whether the marginal employee is willing to participate in the extension of the time period for the marginal employee to achieve the extended at least one goal for enhanced performance (i.e., employee acknowledges the reason

for the time extension in writing, thus being willing to participate, ¶ 13); (n) the employer determining whether the marginal employee has agreed to the extended at least one goal for enhanced performance and the extension of the time period for achieving the at least one goal for enhanced performance (i.e., employee acknowledges the reason for the time extension in writing, ¶ 13); (p) the employer determining whether an advantage to the extension of the time period exists (i.e., rather than remove the employee from the program it may be prudent to give an extension of time, ¶ 13); and (q) the employer determining whether there was a defect in the at least one goal for the enhanced performance of the marginal employee, the time period for achieving the at least one goal or the training provided (i.e., determination that the goals and timetables are realistic, ¶ 8).

Allison does not explicitly disclose (a) the employer considering the marginal employee's effort on a numerical scale; and (o) the employer determining whether any costs of the extension of the time period and the additional training are feasible. Hadden et al disclose a desired performance metric, normalized on a numerical rating scale (¶ 0030). Further, Hadden et al disclose a return on investment (ROI) analysis for training to determine whether the cost of training justifies the increase in performance associated with the training (¶ 0063). Both Allison and Hadden et al are concerned with effective employee evaluation. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include considering the marginal employee's effort on a numerical scale and determining whether the costs are feasible in Allison, as

seen in Hadden et al, as an effective way to quantify the impact of training on actual job performance (see Hadden et al, ¶ 0005).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Bielous (Effective Coaching: Improving Marginal Performers, July 1998) discloses improving the performance of marginal employees through coaching.

-Cleary (You're the Coach, September 1995) discloses coaching as a process for interacting with employees.

-Sutherland (Determining Performance, August 1999) discloses performance management.

-Calderaro et al (US 2003/0004790) disclose improved performance reviews.

-Ibarra (USPN 6119097) disclose quantifying job performance characteristics.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

adb  
January 7, 2006

  
ANDRE BOYCE  
PATENT EXAMINER  
A.U. 3623